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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/525,176	03/14/2000	Savvas Vasileiadis		7655

7590 01/09/2003  
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EXAMINER
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VANOY, TIMOTHY C

ART UNIT	PAPER NUMBER
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1754

17

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09-525,176Applicant(s)  
VASILEAD15Examiner  
VANOYGroup Art Unit  
1754

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- THE AMENDMENT MAILED ON MAY 28, 2002 AND THE AMENDMENT  
☒ Responsive to communication(s) filed on MAILED ON NOV. 3, 2002.  
☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 134-181 is/are pending in the application.  
Of the above claim(s) 138, 141, 143-151, 156-169 & 174-181 is/are withdrawn from consideration.  
☐ Claim(s) \_\_\_\_\_ is/are allowed.  
☒ Claim(s) 134-137, 139, 140, 142, 152-155 & 170-173 is/are rejected.  
☒ Claim(s) 134, 135, 152, 153, 170 AND 171 is/are objected to.  
☒ Claim(s) 134-181 are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☒ The specification is objected to by the Examiner.  
☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).  
☐ All ☐ Some\* ☐ None of the:  
☐ Certified copies of the priority documents have been received.  
☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
☐ Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  
☒ Notice of Reference(s) Cited, PTO-892  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Interview Summary, PTO-413  
☐ Notice of Informal Patent Application, PTO-152  
☒ Other SELECTED SECTIONS FROM THE MPEP

Office Action Summary

## DETAILED ACTION

### *Election/Restrictions*

I The Applicants' election with traverse of the method for producing hydrogen from alcohol and hydrocarbon reformation reactions in their Letter mailed on Nov. 3, 2002 (paper no. 16) is acknowledged. *The traversal is on the ground(s) that the use of hydrogen and syngas in fuel cells and power systems (turbines and engines?) has to be disclosed and included with the invention in order to have a complete invention and subsequent usefulness and applicability benefits. A similar process for producing hydrogen and using it in fuel cells, engines and turbines is set forth in out patent U. S. Pat. No. 6,090,312 from which this application claims priority status.*

This is not found persuasive because the use of hydrogen in fuel cells, engines or turbines does not further limit the claimed and elected method for producing hydrogen from alcohols and hydrocarbons, nor is the use of hydrogen in fuel cells, engines or turbines a part of the invention for *producing* hydrogen from the reformation of alcohols and hydrocarbons such that the elected process for producing hydrogen from fuel cells and hydrocarbons must be further limited to using the hydrogen in fuel cells, engines or turbines. That a similar process for producing hydrogen and using it in fuel cells, engines or turbines was (allegedly) set forth in the Applicants' U. S. Pat. 6,090,312 does not change this.

II Claims 1-48 submitted in the Amendment dated Nov. 1, 2002 have been renumbered under 37 CFR 1.126 as claims 134-181, respectively. As a consequence of the Applicants' election, claims 138, 141, 143-151, 156-169 and 174-181 are

withdrawn from further consideration because they contain limitations directed to the non-elected inventions (please see pg. 4 in the Written Restriction Requirement mailed on Oct. 3, 2002 (paper no. 14)): 37 CFR 1.142(b) and section 821 in the MPEP (8<sup>th</sup> ed.).

III This application contains claims 138, 141, 143-151, 156-169 and 174-181 drawn to inventions non-elected with traverse in the Amendment dated Nov. 1, 2002. A complete reply to the final rejection must include cancellation of the non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

**The requirement is still deemed proper and is therefore made FINAL.**

#### ***Information Disclosure Statement***

The information disclosure statement date stamped 03/14/00 does not fully comply with the requirements of 37 CFR 1.98 because the reference titled "Environmentally benign hydrocarbon processing . . ." published in Reaction Engineering for Pollution Prevention has not been supplied. Since the submission appears to be *bona fide*, the Applicants are given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. **NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).** Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered. See 37 CFR 1.97(i).

Application/Control Number: 09/525,176  
Art Unit: 1754

The Applicants have submitted a paper date-stamped Feb. 27, 2002 which submits that one copy of the reference titled: "Environmentally benign hydrocarbon processing. . ." published in Reaction Eng. for Poll. Prev. has been provided, however no copy of said reference was found with this paper.

The Applicants have also submitted a "Substitute for Form PTO-1449 (Information Disclosure Statement)", but the references cited therein already appear to be of record and cited on the PTO-1449 and PTO-892 forms present in this application file. Hence, the references cited on said "Substitute for Form PTO-1449. . ." have been lined through, since they have already been considered (with the exception of the above mentioned reference published in Reaction Eng. for Poll. Prev.).

**Response to Applicants' "Response to Office Action 11/08/2001"**

The Applicants' substitute specification submitted with their "Response to Office Action 01/29/2002" has not been entered because:

- (i) the "marked up" copy of the substitute specification does not show the changes to the specification of record, as required by 37 CFR 1.125(b)(1), such that the matter being added to the specification and the matter being deleted from the specification is shown. Instead, the "marked up" copy of the specification shows the deletion of an entire original paragraph and the introduction of an entire new paragraph to replace it, but this is not a showing of what the actual *changes* are between the deleted paragraph and the new paragraph. For example, on pgs. 10-12 in the substitute specification, the entire original paragraph no. 9 was deleted and replaced with new paragraph no. 9, but

Art Unit: 1754

the 1<sup>st</sup> sentence in this new paragraph no. 9 does not show that the sole *change* to the 1<sup>st</sup> sentence in the original paragraph was simply inserting "(membrane reactor)" between "reactor" and "designs" (please see section 608.01(q) in the Manual of Patent Examining Procedure (i. e. "MPEP") 8<sup>th</sup> edition for details concerning the criteria for substitute specifications), and

(ii) the substitute specification adds new matter to the original specification, which is prohibited: please also see sections 608.01(q) and 608.04(a) in the MPEP (8<sup>th</sup> ed.) for further details. *For example*, paragraph no. 10 in the "marked-up" copy of the substitute specification includes "higher alcohols" to the list of hydrocarbon feedstocks, which is not supported in the corresponding paragraph in the specification as originally filed on pg. 4, 1<sup>st</sup> full paragraph. Another *example* of new matter can be found in comparing original and new paragraph no.s 19 on pg. 29 et seq. in the "marked up" copy of the substitute specification. The deletion of the sentence: "The heat generated by exothermic reactions in the external shell, may be transferred into the catalytic reaction zone of the inner membrane tube via the radial direction, thus providing part of the heat load necessary to drive the endothermic catalytic reactions in the inner membrane tube." is new matter. Another example of new matter can be found in the deletion of Figure 13 and the deletion of the discussion of Figure 13 set forth on pg. 79 et seq. in the "marked up" copy of the substitute specification.

Therefore, the basis of the examination will be on the specification as originally filed.

The requirement for the submission of a substitute specification presented in the Office Communication mailed 11/08/01 is maintained.

### ***Oath/Declaration***

The oath or declaration submitted with the Amendment mailed on May 28, 2002 is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The specification to which the oath or declaration is directed has not been adequately identified. Specifically, the title of the invention set forth in the oath differs from the title of the invention. See MPEP § 601.01(a).

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application. **Note that pg. 2 in the specification as originally filed sets forth that this application is a continuation-in-part of 08/595,040. In continuation-in-part applications, the oath must refer to the parent application (i. e. 08/595,040, in this case).**

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

It does not identify the mailing or post office address of each inventor. A mailing or post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing or post office address should include the ZIP Code designation. The mailing or post office address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not provide the date that the inventors signed the oath/declaration.

A new oath or declaration is required. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

*The particular declaration form that the Applicants used must be accompanied with an "Application Data Sheet" (37 CFR 1.76). A blank declaration form is being provided with this Office Action.*

### **Specification**

- a) The originally-filed specification is objected to because the lines of the text are not double spaced: please note 37 CFR 1.52(2).
- b) On pgs. 1 and 2 in the originally-filed specification, the "References cited" (to include all the references) should be deleted. The listing of references in the originally-filed specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the Examiner on form PTO-892 or by the Applicants on form PTO-1449, they have not been considered.



- c) The cross reference to the related application 08-595,040 set forth on pg. 2 in the originally-filed specification should be set forth immediately below the title in a separate section titled: "Cross reference to related applications". Additionally, the status of 08-595,040 should be updated by inserting --, now U. S. Patent 6,090,312.-- after "08-595,040".

### ***Claim Objections***

- a) In claim 134, 135, 152, 153, 170 and 171, the word "by" in the phrase "... membrane is made by one or more materials. . ." (and similar phrases) should be replaced with "from".

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 136, 137, 154, 155, 172 and 173 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

- a) The term "rich" in claims 136, 137, 154, 155, 172 and 173 is a relative term which renders these claims indefinite. The term "rich" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The person "having ordinary skill in the art" has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this application reasonably reflect this level of skill.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Application/Control Number: 09/525,176

Art Unit: 1754

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 134-137, 139, 140, 142, 152-155 and 170-173 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document No. 04-182,302 A (hence "JP-302").

Fig. 1 and the description of Fig. 1 set forth in the "Practical Examples 1 and 2" on pgs. 13-16 in the English translation of JP-302 describes an obvious variation of the same method for the steam reformation of hydrocarbons to produce hydrogen and carbon oxides, comprising the steps:

feeding a mixture of steam and the hydrocarbons through inlet (10) into a reactor (100) so that the steam and hydrocarbons react over a Ni on alumina catalyst (16) contained between what appears be a Pd alloy membrane (18) and an outer wall (14) so that the catalyst promotes the conversion of the hydrocarbons and steam into hydrogen and carbon oxides, while being subjected to heat from a heater (12);

transferring a portion of the hydrogen and carbon oxides-containing gas through a gas/liquid separator (28) which separates at least some of the steam/water from the hydrogen-containing mixture *which corresponds to the Applicants' "most inner membrane" since it serves the same purpose of removing some of the water/steam from the hydrogen-containing reaction mixture: please compare the paragraph bridging pgs. 10 and 11 in the English translation of JP-302 to the 1<sup>st</sup> full paragraph on pg. 7 in the Applicants' specification as originally filed;*

transferring the steam-depleted hydrogen -containing gas mixture through a membrane reactor 200, where the hydrogen is selectively separated from the gas mixture via passage through membrane 36 *which corresponds to the Applicants' "next inner membrane"* which is surrounded by what appears to be an impermeable outer wall 34 *which corresponds to the Applicants' "far outer impermeable" wall*, and collecting pure hydrogen from the membrane reactor 200 via line 38.

No unobvious distinction is seen between the materials that the membranes are constructed of; the sources of the hydrocarbon feeds and the steam reformation catalyst used.

The difference between the Applicants' claims and the process illustrated in Fig. 1 in the English translation of JP-302 is that the Applicants' claims call for the use of what appears to be a permeable membrane that allows the passage of the hydrogen and only a portion of the remaining reaction species there through (i. e. the "most inner membrane") with passage of a sweep gas that sweeps away the permeated reaction products from the "most inner membrane", whereas the process of JP-302 uses what appears to be a cooler to condense out some of the water from the hydrogen-containing reaction gas to produce the same hydrogen gas containing only a portion of the remaining reaction species without using any sweep gas to sweep it away from the cooler.

Pg. 2 in the English translation of JP-302 describes a prior art technique for collecting hydrogen generated from the steam reformation of hydrocarbons by injecting the steam and the hydrocarbons into a catalytic unit to produce the reaction gas

containing hydrogen, carbon oxides, steam, etc, and passing the reaction gas through a 1<sup>st</sup> hydrogen permselective membrane so that the hydrogen and a portion of the steam (please also see pg. 6 Ins. 3 and 4 in the English translation of JP-302) permeate through the membrane, and is separated and collected. The 2<sup>nd</sup> full paragraph on pg. 6 in the English translation of JP-302 sets forth that a "method is known" by which an inert gas (in this case, argon) sweeps the hydrogen-containing gas that has permeated through the membrane away from the membrane so that difference in the hydrogen partial pressure on the two sides of the membrane is increased (evidently, so that the reaction equilibrium between the reagents and products is shifted to favor the products).

It would have been obvious to one of ordinary skill in the art at the time the invention was made *to modify* the process illustrated in Fig. 1 in JP-302 *by substituting* the membrane (and concomitant sweep gas) described in the last paragraph on pg. 6 in the English translation of JP-302 *in lieu of* the "cooler" 28, in the manner that would arrive at the invention of the Applicants' claims, *because of the advantage of not only* removing a portion of the non-hydrogen components out of the hydrogen-containing gas (which the "cooler" 28 of JP-302 does) *but also* shifting the reaction equilibrium to favor the production of even more hydrogen by sweeping the permeated hydrogen away from the face of the membrane, as described on pgs. 5 and 6 in the English translation of JP-302.

### ***Response to Arguments***

The Applicants' arguments submitted in their Amendment mailed on May 28, 2002 (paper no. 12) with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

The Applicants' amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

*U. S. PAT. PUB. NO. US 2001/0009653 A1, DISCLOSING A STEAM REFORMATION PROCESS & APPARATUS, IS MADE OF RECORD.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy C. Vanoy whose telephone number is 703-308-2540. The examiner can normally be reached on 8 hr. days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 703-308-3837. The fax phone

Application/Control Number: 09/525,176

Art Unit: 1754

numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Timothy Vanoy/tv  
January 3, 2003

*Timothy Vanoy*  
Timothy Vanoy  
Patent Examiner

Art Unit 1754

*[Signature]*  
SUPERVISOR  
TECHNOLOGY CENTER 1754

**602.01 Oath Cannot Be Amended**

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required. However, in some cases, a deficiency in the oath or declaration can be corrected by a supplemental paper such as an application data sheet (see 37 CFR 1.76 and MPEP § 601.05) and a new oath or declaration is not necessary. See 37 CFR 1.63(c)(1) and (c)(2).

For example, if the oath does not set forth evidence that the notary was acting within his or her jurisdiction at the time he or she administered the oath, a certificate of the notary that the oath was taken within his or her jurisdiction will correct the deficiency. See MPEP § 602 and § 604.02.

Applicant may be so advised by using form paragraph 6.03.

**¶ 6.03 Oath, Declaration Cannot Be Amended**

A new oath or declaration is required because [1]. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

**Examiner Note:**

1. This form paragraph is intended primarily for use in *pro se* applications.
2. Use form paragraph 6.05 and one or more of form paragraphs 6.05.01 to 6.05.20 for a defective oath or declaration in a case where there is a power of attorney.
3. Some corrections may be made by an application data sheet. If the error is correctable by an application data sheet, applicant should be informed of the requirements of an application data sheet. See 37 CFR 1.76 and MPEP § 601.05.

**¶ 6.05.16 Non-Initialed/Non-Dated Alterations**

Non-initialed and/or non - dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

**Examiner Note:**

This paragraph must be preceded by form paragraph 6.05.

**602.02 New Oath or Substitute for Original**

In requiring a new oath or declaration, the examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath or declaration, preferably by giving the application number and the date of filing. Any one of the combinations of information identified in MPEP § 601.01(a) as acceptable for an oath or declaration filed after the filing date may be used.

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but each oath or declaration names all of the inventors and the two taken together give all the required data, no further oath or declaration is needed.

**602.03 Defective Oath or Declaration**

In the first Office action the examiner must point out every deficiency in a declaration or oath and require that the same be remedied. Applicant may be informed of deficiencies in the declaration or oath by form paragraphs 6.05 and 6.05.01 - 6.05.20.

The following form paragraph 6.05 must be used to introduce one or more of Form Paragraphs 6.05.01 - 6.05.20, which explain errors in the oath or declaration. One or more of the following form paragraphs may be used to notify applicant of the objections to the oath or declaration due to a missing "reviewed and understands" statement, "original and first" statement, duty to disclose statement, or if the oath or declaration is not in permanent ink. See MPEP § 602 for defects in the execution of the oath or declaration, failure to properly reference to an earlier foreign application, a missing sole or joint designation, or a failure to properly identify the application papers. See MPEP § 602.04 for a defective foreign executed oath and MPEP § 602.04(a) for an oath with an improperly attached ribbon.

**¶ 6.05 Oath or Declaration Defective, Heading**

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

**Examiner Note:**



### 608.04(a) Matter Not in Original Specification, Claims, or Drawings

Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers*, 108 USPQ 444 (Bd. App. 1955) (new use). For rejection of claim involving new matter, see MPEP § 706.03(o).

For completeness of disclosure, see MPEP § 608.01(p). For trademarks and tradenames, see MPEP § 608.01(v).

### 608.04(b) New Matter by Preliminary Amendment

An amendment is sometimes filed along with the filing of the application. Where a 37 CFR 1.53(b) application is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. The subsequently filed oath or declaration must refer to both the application and the amendment. See MPEP § 714.09.

An amendment which adds additional disclosure filed with a request for a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 is automatically considered a part of the original disclosure of the application by virtue of the rule. Therefore, the oath or declaration filed in such an application must identify the amendment adding additional disclosure as one of the papers which the inventor(s) has "reviewed and understands" in order to comply with 37 CFR 1.63. If the original oath or declaration submitted in a continuation-in-part application filed prior to December 1, 1997 under former 37 CFR 1.62 does not contain a reference to the amendment filed with the request for an application under former 37 CFR 1.62, the examiner must require a supplemental oath or declaration referring to the amendment.

### 608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. 37 CFR 1.181 and 37 CFR 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

### 608.05 Sequence Listing Table, or Computer Program Listing Appendix Submitted on a Compact Disc

37 CFR 1.52. Language, paper, writing, margins, compact disc specifications.

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(c) Electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding.

(1) The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

- (i) A computer program listing (see § 1.96);
- (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
- (iii) A table (see § 1.58) that has more than 50 pages of text.

(2) A compact disc as used in this part means a Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) in compliance with this paragraph. A CD-ROM is a "read-only" medium on which the data is pressed into the disc so that it cannot be changed or erased. A CD-R is a "write once" medium on which once the data is recorded, it is permanent and cannot be changed or erased.

(3)(i) Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII).

(ii) Each compact disc must be enclosed in a hard compact disc case within an unsealed padded and protective mailing envelope and accompanied by a transmittal letter on paper in accordance with paragraph (a) of this section. The transmittal letter must list for each compact disc the machine format (e.g., IBM-PC, Macintosh), the operating system compatibility (e.g., MS-DOS, MS-Windows, Macintosh, Unix), a list of files contained on the compact disc including their names, sizes in bytes, and dates

reference which may not be readily available. Through the Office's incorporation by reference policy, the Office ensures that reasonably complete disclosures are published as U.S. patents. The same policy concern does not apply where the sole purpose for which an applicant relies on an earlier U.S. or foreign application is to establish an earlier filing date. Incorporation by reference in the earlier application of (1) patents or applications published by foreign countries or regional patent offices, (2) nonpatent publications, (3) a U.S. patent or application which itself incorporates "essential material" by reference, or (4) a foreign application, is not critical in the case of a "benefit" application.

When an applicant, or a patent owner in a reexamination or interference, claims the benefit of the filing date of an earlier application which incorporates material by reference, the applicant or patent owner may be required to supply copies of the material incorporated by reference. For example, an applicant may claim the benefit of the filing date of a foreign application which itself incorporates by reference another earlier filed foreign application. If necessary, due to an intervening reference, applicant should be required to supply a copy of the earlier filed foreign application, along with an English language translation. A review can then be made of the foreign application and all material incorporated by reference to determine whether the foreign application discloses the invention sought to be patented in the manner required by the first paragraph of 35 U.S.C. 112 so that benefit may be accorded. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

## II. SIMULATED OR PREDICTED TEST RESULTS OR PROPHETIC EXAMPLES

Simulated or predicted test results and prophetic examples (paper examples) are permitted in patent applications. Working examples correspond to work actually performed and may describe tests which have actually been conducted and results that were achieved. Paper examples describe the manner and process of making an embodiment of the invention which has not actually been conducted. Paper examples should not be represented as work actually done. No results should be represented as actual results unless they have actually been achieved. Paper examples should not be described using the past tense.

For problems arising from the designation of materials by trademarks and trade names, see MPEP § 608.01(v).

## 608.01(q) Substitute or Rewritten Specification

### 37 CFR 1.125. Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:

(1) A statement that the substitute specification includes no new matter; and

(2) A marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with § 1.121(b)(1).

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

The specification is sometimes in such faulty English that a new specification is necessary; in such instances, a new specification should be required.

Form paragraph 6.28 may be used where the specification is in faulty English.

### ¶ 6.28 Idiomatic English

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

37 CFR 1.125(a) applies to a substitute specification required by the Office. If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof be rewritten.

Form paragraph 6.28.01 may be used where the examiner, for reasons other than faulty English, requires a substitute specification.

**¶ 6.28.01 Substitute Specification Required by Examiner**

A substitute specification [1] the claims is required pursuant to 37 CFR 1.125(a) because [2].

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and must be accompanied by: 1) a statement that the substitute specification contains no new matter; and 2) a marked-up copy showing the amendments to be made via the substitute specification relative to the specification at the time the substitute specification is filed.

**Examiner Note:**

1. In bracket 1, insert either -- excluding-- or -- including--.
2. In bracket 2, insert clear and concise examples of why a new specification is required.
3. A new specification is required if the number or nature of the amendments render it difficult to consider the application or to arrange the papers for printing or copying, 37 CFR 1.125.
4. See also form paragraph 13.01 for partial rewritten specification.
5. 37 CFR 1.125(b) provides applicants with the right of entry of substitute specifications, under the conditions set forth in the section, in applications other than reissue applications (37 CFR 1.125(d)) that have not been required by the examiner.

37 CFR 1.125(b) applies to a substitute specification voluntarily filed by the applicant. A substitute specification, excluding claims, may be voluntarily filed by the applicant at any point up to the payment of the issue fee provided it is accompanied by (1) a statement that the substitute specification includes no new matter, and (2) a marked-up copy of the substitute specification showing the matter being added to and the matter being deleted from the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown under 37 CFR 1.125(b)(2). 37 CFR 1.125(b). The Office will accept a substitute specification voluntarily filed by the applicant if the requirements of 37 CFR 1.125(b) are satisfied.

37 CFR 1.125(c) requires a substitute specification filed under 37 CFR 1.125(a) or (b) be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in

Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with 37 CFR 1.121(b)(1).

A substitute specification filed under 37 CFR 1.125(b) must be accompanied by a statement indicating that no new matter was included. There is no obligation on the examiner to make a detailed comparison between the old and the new specifications for determining whether or not new matter has been added. If, however, an examiner becomes aware that new matter is present, objection thereto should be made.

The filing of a substitute specification rather than amending the original application has the advantage for applicants of eliminating the need to prepare an amendment of the specification. If word processing equipment is used by applicants, substitute specifications can be easily prepared. The Office receives the advantage of saving the time needed to enter amendments in the specification and a reduction in the number of printing errors. A substitute specification is not permitted in a reissue application or in a reexamination proceeding. 37 CFR 1.125(d).

A substitute specification which complies with 37 CFR 1.125 should normally be entered. The examiner should write "Enter" or "OK to Enter" and his or her initials in ink in the left margin of the first page of the substitute specification. A substitute specification which is denied entry should be so marked.

Form paragraph 6.28.02 may be used to notify applicant that a substitute specification submitted under 37 CFR 1.125(b) has not been entered.

**¶ 6.28.02 Substitute Specification Filed Under 37 CFR 1.125(b) Not Entered.**

The substitute specification filed [1] has not been entered because it does not conform to 37 CFR 1.125(b) because: [2]

**Examiner Note:**

1. In bracket 2, insert statement of why the substitute specification is improper, for example:
  - the statement as to a lack of new matter under 37 CFR 1.125(b) is missing--;
  - a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy)--;
  - a clean copy of the substitute specification has not been supplied (in addition to the marked-up copy)--;
  - the substitute specification has been filed:
    - in a reissue application or in a reexamination proceeding, 37 CFR 1.125(d)-;
    - after payment of the issue fee-;
    - containing claims (to be amended)-;

See MPEP § 714.20 regarding entry of amendments which include an unacceptable substitute specification.

For new matter in amendment, see MPEP § 608.04.

For application prepared for issue, see MPEP § 1302.02.

### **608.01(r) Derogatory Remarks About Prior Art in Specification**

The applicant may refer to the general state of the art and the advance thereover made by his or her invention, but he or she is not permitted to make derogatory remarks concerning the inventions of others. Derogatory remarks are statements disparaging the products or processes of any particular person other than the applicant, or statements as to the merits or validity of applications or patents of another person. Mere comparisons with the prior art are not considered to be disparaging, *per se*.

### **608.01(s) Restoration of Canceled Matter**

Canceled text in the specification can be reinstated only by a subsequent amendment presenting the previously canceled matter as a new insertion. 37 CFR 1.121(b)(4). A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. 37 CFR 1.121(c)(2). See MPEP § 714.24.

### **608.01(t) Use in Subsequent Application**

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application. 37 CFR 1.79; MPEP § 608.01(e).

No part of a specification can normally be transferred to another application. Drawings may be transferred to another application only upon the granting of a petition filed under the provisions of 37 CFR 1.182. See MPEP § 608.02(i).

### **608.01(u) Use of Formerly Filed Incomplete Application**

Parts of an incomplete application which have been retained by the Office may be used as part of a complete application if the missing parts are later supplied. See MPEP § 506 and § 506.01.

## **608.01(v) Trademarks and Names Used in Trade**

The expressions "trademarks" and "names used in trade" as used below have the following meanings:

**Trademark:** a word, letter, symbol, or device adopted by one manufacturer or merchant and used to identify and distinguish his or her product from those of others. It is a proprietary word, letter, symbol, or device pointing distinctly to the product of one producer.

**Names Used in Trade:** a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public, generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

(A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(B) In this country, their meanings are well-known and satisfactorily defined in the literature.

Condition (A) or (B) must be met at the time of filing of the complete application.

### **TRADEMARKS**

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931).

However, if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes

## 821.01 After Election With Traverse

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

### ¶ 8.25 Answer to Arguments With Traverse

Applicant's election with traverse of [1] in Paper No. [2] is acknowledged. The traversal is on the ground(s) that [3]. This is not found persuasive because [4].

The requirement is still deemed proper and is therefore made FINAL.

#### Examiner Note:

1. In bracket 1, insert the invention elected.
2. In bracket 3, insert in summary form, the ground(s) on which traversal is based.
3. In bracket 4, insert the reasons why the traversal was not found to be persuasive.

If the examiner, upon reconsideration, is of the opinion that the requirement for restriction is improper, he or she should state in the next Office action that the requirement for restriction is withdrawn and give an action on all the claims.

If the requirement is repeated and made final, in that and in each subsequent action, the claims to the nonelected invention should be treated by using form paragraph 8.05.

### ¶ 8.05 Claims Stand Withdrawn With Traverse

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected [2], there being no (allowable) generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. [3].

#### Examiner Note:

In bracket 2, insert --invention-- or --species--.

This will show that applicant has retained the right to petition from the requirement under 37 CFR 1.144. (See MPEP § 818.03(c).)

When the case is otherwise ready for issue, and has not received a final action, the examiner should treat the case by using form paragraph 8.03. (See MPEP § 809.02(c).)

When preparing a final action in an application where there has been a traversal of a requirement for

restriction, the examiner should indicate in the Office action that a complete reply must include cancellation of the claims drawn to the nonelected invention, or other appropriate action (37 CFR 1.144). See form paragraph 8.24.

### ¶ 8.24 Reply to Final Must Include Cancellation

This application contains claim [1] drawn to an invention nonelected with traverse in Paper No. [2]. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

#### Examiner Note:

For use in FINAL rejections of applications containing claims nonelected with traverse.

Where a reply to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the nonelected invention or to take appropriate action will be construed as authorization to cancel these claims by examiner's amendment and pass the application to issue after the expiration of the period for reply.

Note that the petition under 37 CFR 1.144 must be filed not later than appeal. This is construed to mean appeal to the Board of Patent Appeals and Interferences. If the application is ready for allowance after appeal and no petition has been filed, the examiner should simply cancel the nonelected claims by examiner's amendment, calling attention to the provisions of 37 CFR 1.144.

## 821.02 After Election Without Traverse

Where the initial requirement is not traversed, if adhered to, appropriate action should be given on the elected claims. Form paragraphs 8.25.01 or 8.25.02 should be used by the examiner to acknowledge the election without traverse.

### ¶ 8.25.01 Election Without Traverse

Applicant's election without traverse of [1] in Paper No. [2] is acknowledged.

### ¶ 8.25.02 Election Without Traverse Based on Incomplete Reply

Applicant's election of [1] in Paper No. [2] is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims to the nonelected invention should be treated by using form paragraph 8.06.

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the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (A) a divisional or (B) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the examiner should make a new restriction requirement in the first action.

### 819.01 Office May Waive Election and Permit Shift

While applicant, as a matter of right, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues. *Ex parte Heritage*, Pat. No. 2,375,414 decided January 26, 1944. If the examiner has accepted a shift from claiming one invention to claiming another, the case is not abandoned. *Meden v. Curtis*, 1905 C.D.272, 117 O.G. 1795 (Comm'r Pat. 1905).

### 820 Not an Election; Permissible Shift

Where the Office rejects on the ground that the process is obvious, the only invention being in the product made, presenting claims to the product is not a shift: *Ex parte Trevette*, 1901 C.D. 170, 97 O.G. 1173 (Comm'r Pat. 1901).

Where a product is elected, there is no shift where examiner holds invention to be in the process. *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923).

Where a genus is allowed, applicant may prosecute a reasonable number of additional species thereunder, in accordance with 37 CFR 1.141. This does not constitute a shift. *Ex parte Sharp*, Patent No. 2,232,739.

### 820.01 Old Combination Claimed — Not an Election

Where an application originally presents claims to a combination (AB) and the examiner holds the novelty, if any, to reside only in the subcombination (B) *per se* (see MPEP § 806.05(b)), and the claims directed to the combination are rejected, subsequently presented claims to subcombination (B) of the originally claimed combination should not be held constructively nonelected on the ground of previous election of the combination. See MPEP § 821.03. *Ex parte Donnell*, 1923 C.D. 54, 315 O.G. 398 (Comm'r Pat. 1923). The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. See MPEP § 806.05(c).

### 820.02 Interference Issues — Not an Election

Where an interference is instituted prior to an applicant's election, the subject matter of the interference issues is not elected. An applicant may, after the termination of the interference, elect any one of the inventions claimed.

### 821 Treatment of Claims Held To Be Drawn to Nonelected Inventions

Claims held to be drawn to nonelected inventions, including claims to nonelected species, are treated as indicated in MPEP § 821.01 through § 821.03.

The propriety of a requirement to restrict, if traversed, is reviewable by petition under 37 CFR 1.144. *In re Hengehold*, 440 F.2d 1395, 169 USPQ 473 (CCPA 1971).

All claims that the examiner holds as not being directed to the elected subject matter are withdrawn from further consideration by the examiner in accordance with 37 CFR 1.142(b). See MPEP § 809.02(c) and § 821.01 through § 821.03. The examiner should clearly set forth in the Office action the reasons why the claims withdrawn from consideration are not readable on the elected invention. Applicant may traverse the requirement pursuant to 37 CFR 1.143. If a final requirement for restriction is made by the examiner, applicant may file a petition under 37 CFR 1.144 for review of the restriction requirement.

evidence of obviousness in substituting one for the other in an electrophotographic environment as a photoconductor." 209 USPQ at 759.).

An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

### 2144.07 Art Recognized Suitability for an Intended Purpose

The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (Claims to a printing ink comprising a solvent having the vapor pressure characteristics of butyl carbitol so that the ink would not dry at room temperature but would dry quickly upon heating were held invalid over a reference teaching a printing ink made with a different solvent that was nonvolatile at room temperature but highly volatile when heated in view of an article which taught the desired boiling point and vapor pressure characteristics of a solvent for printing inks and a catalog teaching the boiling point and vapor pressure characteristics of butyl carbitol. "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.).

See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988) (Claimed agricultural bagging machine, which differed from a prior art machine only in that the brake means were hydraulically operated rather than mechanically operated, was held to be obvious over the prior art machine in view of references which disclosed hydraulic brakes for performing the same function, albeit in a different environment.).

### 2144.08 Obviousness of Species When Prior Art Teaches Genus

#### I. GUIDELINES FOR THE EXAMINATION OF CLAIMS DIRECTED TO SPECIES OF CHEMICAL COMPOSITIONS BASED UPON A SINGLE PRIOR ART REFERENCE

These "Genus-Species Guidelines" are to assist Office personnel in the examination of applications which contain claims to species or a subgenus of chemical compositions for compliance with 35 U.S.C. 103 based upon a single prior art reference which discloses a genus encompassing the claimed species or subgenus but does not expressly disclose the particular claimed species or subgenus. Office personnel should attempt to find additional prior art to show that the differences between the prior art primary reference and the claimed invention as a whole would have been obvious. Where such additional prior art is not found, Office personnel should follow these guidelines to determine whether a single reference 35 U.S.C. 103 rejection would be appropriate. The guidelines are based on the Office's current understanding of the law and are believed to be fully consistent with binding precedent of the Supreme Court, the Federal Circuit, and the Federal Circuit's predecessor courts.

The analysis of the guidelines begins at the point during examination after a single prior art reference is found disclosing a genus encompassing the claimed species or subgenus. Before reaching this point, Office personnel should follow appropriate antecedent examination procedures. Accordingly, Office personnel should first analyze the claims as a whole in light of and consistent with the written description, considering all claim limitations. When evaluating the scope of a claim, every limitation in the claim must be considered. See, e.g., *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). However, the claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered as a whole. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983); *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1983) ("treating the advantage as the invention disregards the statutory requirement that the invention be

## PARTS, FORM, AND CONTENT OF APPLICATION

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PTO/SB/01 (03-01)

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<b>DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63)</b>  <input type="checkbox"/> Declaration Submitted with Initial Filing      OR <input type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)	<b>Attorney Docket Number</b>	
	<b>First Named Inventor</b>	
	<b>COMPLETE IF KNOWN</b>	
	<b>Application Number</b>	/
	<b>Filing Date</b>	
	<b>Group Art Unit</b>	
	<b>Examiner Name</b>	

As a below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

--

(Title of the Invention)

the specification of which

☐ is attached hereto

OR

☐ was filed on (MM/DD/YYYY)

as United States Application Number or PCT International

Application Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
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☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 21 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



## MANUAL OF PATENT EXAMINING PROCEDURE

PTO/SB/01 (03-01)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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City				State		ZIP	
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.							
NAME OF SOLE OR FIRST INVENTOR :				<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle [if any])				Family Name or Surname			
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Given Name (first and middle [if any])				Family Name or Surname			
Inventor's Signature						Date	
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<input type="checkbox"/> Additional inventors are being named on the ____ supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto.							

[Page 2 of 2]